APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,114	10/25/2000	Toru Kobayashi	00745/LH	4404

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/696,114	Applicant(s) KOBAYASHI ET AL.
	Examiner Calvin L Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2003* .

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *124-165* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *124-165* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

Status of Claims

1.   Claims 124-165 have been examined.

2.   Applicant's arguments with respect to claims 124-165 have been
considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

4.   Claims 150-165 are rejected under 35 U.S.C. 112, second paragraph, as
being indefinite for failing to particularly point out and distinctly claim the subject
matter which applicant regards as the invention.

Claim 150 recites, "job ID information sent from the print service station" in
line 3. Claim 151 also recites "job ID information sent from the print service
station". There is insufficient antecedent basis for these limitations in their
respective claims, because in claim 149 the "job ID information" is not transmitted
from the print service station.

Claims 152-165 are also rejected as they depend from claim 151.

5.   Claim 164 recites "a cryptographic key for each client" in line 3. There is in

There is insufficient antecedent basis for this limitations in the claim.

Claims 165 is also rejected as it depends from claim 164.

6.   Claims 163-165 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Claim 163 recites "the print service station requests a log-in for the data

service system". However, to one of ordinary skill a "log-on" requires human

interaction, such as a user supplying a username or ID, and password.

Claims 164 and 165 are also rejected as they depend from claim 163.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 142 and 147-152 are rejected under 35 U.S.C. 102(e) as being

clearly anticipated by Stefik et al. by U.S. Patent No. 6,233,684.

As per claims 142 and 147-152 Stefik et al. teach a print system for use

through a network comprising:

- a data service system, with a communication section, connected to

  a network having a storage section in which a plurality of data (e.g.

  book data) are stored in a plurality of data storing locations and a

  calculating section to calculate a payment to be charged in

  accordance with the printing result (abstract; figures 1, 2 and 5;

  column 5, lines 35-40)

- a plurality of printer service stations connected to the network

  comprising: input for inputting a print specification of a customer to

  print an ordered book from the data storage location and printing

  the book data (figure 16; column 5, lines 35-40; column 6, lines 1-

  28; column 8,lines 3-38)

- a data processing section for compiling the image data in

  accordance with the specification, the print section printing in

  accordance with the specification, and a book copying system for

  determining a charge for the ordered book based on the print

  specification (figure 16; column 5, lines 35-40; column 6, lines 1-28;

  column 8, lines 3-38; column 9, lines 13-63)

- transmitting order signal from customer to the data service system

    and the data service system (e.g. data managing section)

    transmitting job ID information and image data on the basis of the

    job ID information to the printer station in response to the order

    (figures 5-7; column 8, lines 25-38)

- transmitting stored estimated payment information (e.g. relating to

    royalties, service charge for providing image data) to the customer,

    by the service system and the customer indicating a payment on

    the basis of the payment information (e.g. calculating a copy

    charge) (abstract; figures 6 and 7; column 5, lines 7-10; column 9,

    lines 14-60; column 13, lines 10-19)

- a data managing section transmitting a data storing location (e.g.

    the file, watermark) to the print section (column 8, lines 5-38)

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 124-140, 141, and 143-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684.

As per claims 124-140, 141 and 143-146; Stefik et al. teach a print system for use through a network comprising:

- a service system, with a communication section, connected to a network having a storage section in which a plurality of data are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5)

- a printer service station in connection with the service system, to order and produce a copy of a digital work (e.g. book) (figures 3 and 5; column 5, lines 35-40; column 7, lines 10-20)

Regarding charges by the data service system and print service station. The data service system charges users for accessing the digital work (figure 6). Stefik et al. also disclose a "print store" (figure 16) that is distinct and separate from the user workstation, as well as the data service system, hence it is at least obvious that the "print store" would charge a fee for providing print services, such as for making use of (e.g. renting) materials such as printers, computers... etc.

Regarding charge reduction, coupons and "volume discounts" are well known to those of order skill of retail management.

Stefik et al. also teach:

- a communicating system notifying the service system of the printing result by the client system (column 13, lines 10-19)

- a printer client system with a finishing section, print failure detection section that indicates a success or failure of image formation and transmits an indicator of the result, and charges payment on the basis of successful printing(s) (column 13, lines 10-19)

- a plurality of printers and setting a print charge for each of the plurality of printers (figure 16)

- calculating a payment to be charged in accordance with the printing result (column 13, lines 10-19)

- Stefik et al. teach calculating a charge at the data service system (column 13, lines 10-19; column 15, lines 53-65). Similarly, a store that provides data printing services comprises a calculating section that calculates a charge for making use of said services (figure 16). Therefore, it would have been obvious to integrate the charge calculation function such that it exists at either or both facilities for efficiency or security (if the publisher finds the remote print system lacking- figure 16, column 17, lines 7-10). Regarding copyright fees,

- it would have been obvious to one of ordinary skill to not apply

  copyright fees if copyright fees didn't apply, for example, in the

  event the copyright has terminated.

As per claims 143-146, Stefik et al. teach service charges that are valid for

a period of time (column 5, lines 47-59). Stefik et al. also teach a "print store"

(figure 16). Therefore, it is at least obvious that a print store employee can quote

an end-user an estimated cost for making use of the print store's services. Stefik

et al. teach transmitting stored estimated payment information (e.g. relating to

royalties, service charge for providing image data) to the client system, by the

service system (e.g. data server, master server) and the client system indicating

a payment on the basis of the payment information (e.g. calculating a copy

charge) (abstract; figures 6 and 7; column 5, lines 7-10; column 9, lines 14-60;

column 13, lines 10-19) Stefik et al. teach calculating a charge at the data service

system (column 13, lines 10-19; column 15, lines 53-65). Similarly, a store that

provides data printing services comprises a calculating section that calculates a

charge for making use of said services (figure 16). Therefore, it would have been

obvious to integrate the charge calculation function such that it exists at either or

both facilities for efficiency or security (if the publisher finds the remote print

system lacking- figure 16, column 17, lines 7-10). Regarding copyright fees, it

would have been obvious to one of ordinary skill to not apply copyright fees if

copyright fees didn't apply, for example, in the event the copyright has

terminated.

11.   Claims 141 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Stefik et al., U.S. Patent No. 6,233,684 in view of Yoshiura et al., U.S.

Patent No. 6,131,162.

As per claims 141, Stefik et al. teach a system for secured printing using

cryptography (abstract; figures 1, 2 and 5). However, Stefik et al. do not explicitly

recite the printer client system applying a digital signature to requested data

using public key or other cryptographic scheme. Yoshiura et al. teach a system

for securing data where a client system digitally signs requested data using

public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column

12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to

combine the teachings of Stefik et al. and Yoshiura et al. in order to identify

illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines

30-48).

12.   Claims 153-161 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Hatrick et

al., U.S. Patent No. 5,532,920.

As per claims 153-161 Stefik et al. teach a system for secured printing that

allows users to download digital works and compensates creators for the use of

their digital works, uses cryptographic communications to exchange data

between a remote data service system and a consumer system (abstract; figures

1, 2 and 5-7; column 13, lines 10-19). Claims 153-155 are broad enough to read

on mere downloading data from a remote location over a communication network

such as the internet. A process that is old and well known. Stefik et al. teach a

book copying system comprising:

- encrypting the requested data by the service system and the printer

  client system downloading the encrypted request data, decrypting

  the data and conducting printing on the basis of the decrypted data

  (figure 5)

- encrypting the requested data by the service system and the printer

  client system downloading the encrypted request data, decrypting

  the data and conducting printing on the basis of the decrypted data

  (figure 5)

Stefik et al. also teach notifying the server system of successful printing and

processes based on the print result (abstract; figures 1, 2 and 5-7; column 13,

lines 10-19). Stefik et al. also teach billing a user after it is verified that successful

printing took place (column 13, lines 10-19). Therefore, to one of ordinary skill it

would have been obvious to consider unsuccessful attempts as "trial" printing

and not to adjust the charge so as to not charge a user for an unsuccessful copy

attempt (e.g. charging based on the printing result). Similarly, it would have been

obvious for the "print store" (figure 16) to maintain such a policy regarding

defective printing. However, Stefik et al. do not specifically recite book printing or

page unit basis. On the other hand, Stefik et al. apply their system to document

printing (column 13, lines 43-45). Hence, a user has the ability to print a one

page or multi-page document and select the frequency for printing each page

(figure 12). Hartick et al. teach a system for compensating content creators for

the right to access digital works on a book or chapter basis (abstract; figures 9A-

11; column 12, lines 8-20) and a service system that changes a page

arrangement order in accordance with a processing capability of the printer client

system such as a selected access mode (e.g. chapter or book) (column 12, lines

8-20). In addition, it would have been obvious to one of ordinary skill to not apply

copyright fees if the copyright has terminated. Therefore, it would have been

obvious to one of ordinary skill to combine the systems of Stefik et al. and Hartick

et al. in order to provide a user with the ability to access portions of a digital work

as opposed to accessing the entire work ('684, abstract; '920, figure 11; column

12, lines 9-18).

13.   Claims 160-162 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Hatrick et al., U.S.

Patent No. 5,532,920, as applied to claim 159 and in further view of Yoshiura et

al., U.S. Patent No. 6,131,162.

As per claims 160-162, Stefik et al. teach a system for secured printing

that allows users to download digital works and compensates creators for the use

of their digital works (abstract; figures 1, 2 and 5-7). Hartick et al. teach a system

for compensating content creators for the right to access digital works on a book

or chapter basis (abstract; figures 9A-11; column 12, lines 8-20) and a service

system that changes a page arrangement order in accordance with a processing

capability of the printer client system such as a selected access mode (e.g.

chapter or book) (column 12, lines 8-20). However, neither Stefik et al. nor

Hartrick et al. explicitly recite digital signatures. Yoshiura et al. teach a system for

securing data where a client system digitally signs requested data using public

key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12,

lines 12-28). Therefore, it would have been obvious to one of ordinary skill to

combine the teachings of Stefik et al., Hartrick et al. and Yoshiura et al. in order

to further secure the system ('684, figure 1) by incorporating the ability to identify

illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

14.   Claims 163 and 165 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Servi, U.S. Patent No. 5,278,904.

As per claims 163 and 165, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). However, Stefik et al. do not teach logging on to a server. Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Servi in order to prevent unwanted access to the system.

15.   Claim 164 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Servi, U.S. Patent No. 5,278,904, as applied to claim 163 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claim 164, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). However, neither reference teaches digital signatures. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Servi et al. and Yoshiura et al. in order to further secure the system ('684, figure 1) by incorporating the ability to identify illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

Conclusion

16.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

17.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (703) 308-8057. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and
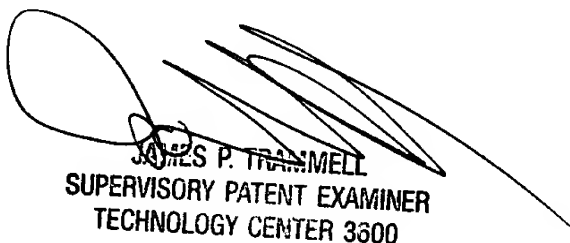
after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,

2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application

should be directed to the Group receptionist whose telephone number is (703)

308-1113.

Calvin Loyd Hewitt II

September 30, 2003

JAMES P. TRAMMELL
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